

2. (Once Amended) A heated coffee mug apparatus [5] comprising:

a generally standard drinking vessel;

a mug holder for surrounding and providing firm mechanical communication with said drinking vessel, said mug holder having a base having a flat lower surface for resting upon a horizontal surface;

a heating element located within said mug holder; and

a power cord electrically coupled with a power plug and in electrical communication with said heating element.

#### REMARKS

Reconsideration of the application as amended is respectfully requested.

Claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Vaneslow.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that only the CLAIMED designs are to be compared. Many differences exist between the design claimed in Vaneslow, and the currently claimed design. To briefly summarize the distinguishing features and characteristics of each, Vaneslow, discloses and claims a cup warming device having a receiving member with an extended cylindrical cavity.

The present invention includes a number of features that are unanticipated in the above mentioned references. For example, the present invention includes:

- a lid;

- a heating elements retained within a base AND powered by 12 volts DC ;
- The ability to use the base with a standard drinking mug;
- a power plug is capable of connecting directly to a motor vehicle's power system;
- a flexible resistive type heat element located on the interior side of the coffee mug holder, to provide heat via direct mechanical communication to the standard containerized food vessel

Accordingly, the rejection by the examiner under 35 U.S.C. 102(b) is inappropriate.

The examiner respectfully rejected Claim 5+6 under 35 U.S.C. 103(a) as being unpatentable over the same single reference. Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument application wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the examiners arguments that would suggest the desirability or obviousness of making heating element powered by a vehicle's electrical system for heating a conventional drinking mug in a manner that flexibly retains the mug in firm mechanical contact. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

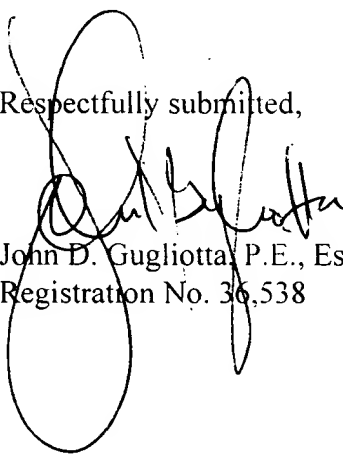
To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements.

To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art. relevant or not, is also inappropriate.

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,

  
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